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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,094	06/22/2000	JUN KITAMURA	000725	8068

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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/582,094

Applicant(s)

KITAMURA ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002 and 06 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the Pre-amendment (Paper No. 4) of 6/22/2000.

Election/Restrictions

2. Applicant's election without traverse of the invention of Group I, species B(2) in Paper Nos. 7 and 9 of 8/7/02 and 11/6/02, respectively is acknowledged.

As a result of applicant's election, claims 11, 13-18 and 20 are examined in this Office action, and claims 1-10, 12 and 19 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species. Election was made **without** traverse in Paper Nos. 7 and 9.

It is noted that there is not any generic or linking claim(s) between the inventions of Group I (claims 1-18 and 20) and the invention of Group II (claim 19), and there is not any generic claim(s) between the species A (claims 1-10) and Species B (claims 11-18 and 20); however, claims 11 and 15 are generic claims for the Species B(1) (claim 13-14 and 16) and Species B(2) (claim 12); therefore, claim 12 will be rejoined into the application if the generic claims 11 and 15 are later found to be allowable.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings contain twenty-four sheets of figures 1-24(b0 filed by applicant on 6/22/2000 were received by the Office.

5. Figures 24 (a) and 9b) should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See specification at pages 2 and 9. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In particular, the reference "111" as shown in figures 12-13 is not mentioned in the specification; and the reference "L'" as shown in figure 19(b) is not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the reference "14" stated in page 11, line 2; the references "123" and "132" as stated in page 15, lines 20 and 27, respectively; and the reference "131b" stated in page 16, line 14 are not shown in at least one figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to

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avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature relating to means of light emission and reception has polarizing plates as recited in each of claims 14 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11, 13-14, 16 and (17, 18, 20)/(11, 13, 14, 16) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 11 is rejected under 35 USC 112, second paragraph because each of the features "the mirror surface" (line 7) and "the thus reflected and returned image light" (line 10) lacks a proper antecedent basis. Further, it is suggested that 1) the terms "this means" (line 6) be changed to --said means--; and 2) the terms "the said" (lines 8, 9 and 11) should be changed to --the-- or --said--.

b) Claim 13 is rejected under 35 USC 112, second paragraph because each of the features "the mirror surface" (lines 6-7); "the baseline surface" (lines 8-9) and "the thus reflected and returned image light" (lines 13-14) lacks a proper antecedent basis. Further, it is suggested that 1) the terms "this means" (line 6) be changed to --said means--; and 2) the terms "the said" (lines 8, 9, 10, 11, 12 and 14) should be changed to --the-- or --said--.

c) Claim 14 is rejected under 35 USC 112, second paragraph because each of the features "the mirror surface" (lines 6-7); "the baseline surface" (lines 8-9) and "the thus reflected and returned image light" (line 15) lacks a proper antecedent basis. Further, it is suggested that 1) the terms "this means" (line 6) be changed to --said means--; and 2) the terms "the said" (lines 8, 9, 10, 11, 13, 14 and 16) should be changed to --the-- or --said--.

d) Claim 16 is rejected under 35 USC 112, second paragraph because the feature "the base side surface" (lines 6-7) lacks a proper antecedent basis. Further, it is suggested that the terms "this means" (line 3) be changed to --said means--

e) It is suggested that in claim 15, the terms "this means" (line 3) be changed to

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--said means--; and 2) the terms "the said" (lines 6 and 7) should be changed to --the-- or --said--.

f) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

Double Patenting

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Claim 20/11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 11. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

14. Claim 17/14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 11, 15, and (18, 20)/(11, 15), as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Larimore (U.S. Patent No. 2,102,274).

Larimore discloses a microscope for pathological research. The microscope as described in columns 2-3 and shown in figures 1-5 comprises a means having a tubular case (13) having a straight-through bore (14) for supporting a light source (15,16) and another tubular case (6) having a reception bore for receiving light from a object wherein the bore of the light emission is arranged separately from the bore of light reception. A rectangular prism-shaped element (30) disposed adjacent to the bores of light emission and light reception wherein the element (30) comprises a mirror surface (30b) oriented by an angle of 45 degrees with respect to line of vision of the microscope wherein the mirror surface (30b) is formed on the tip of the member (30). The member acts as a guide for reflecting emission light from the light source to the object and for reflecting the light from the object to an eyepiece of the microscope via the reception bore. It is also noted that the member (30) is detachably attached to the end of the microscope via a mechanism having recess, flange and pin (27-29). See column 3 and column 4 (lines 21-24). With regard to the feature concerning the dimension of

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the member, while Larimore does not clearly state that the member (30) has a thin thickness; however, since the thickness of the member (30) as shown in the figures, in particular, the figure 1, shown as the one having a thin thickness; and 2) the pending claims fail to specify the dimension of the so-called "thin" thickness; therefore, the feature relating to the dimension of the member claimed is considered as an inherent feature of the member (30) disclosed by Larimore.

17. Claims 16 and 20/16, as best as understood, are rejected under 35

U.S.C. 102(b) as being anticipated by Kohayakawa et al (U.S. Patent No. 4,830,483).

Kohayakawa et al disclose an optical device having a means for providing light emission to an object and for reception light from the object to an observer. The means for providing light and for reception light comprises a rectangular thin-like element (22) having a mirror surface (22c) formed on the tip of the element and a half mirror formed on the base side surface of the element. See Kohayakawa et al, column s 2-3 and figs. 1(a-b), for example.

Conclusion

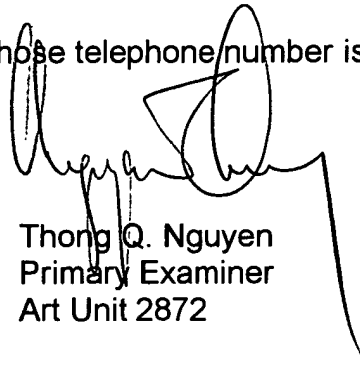
18. The additional references are cited as of interest in that each discloses an optical device having an illumination system and an imaging system wherein the illumination system comprises a reflecting element disposed near an object for guiding light from the illumination system to the object. The U.S. Patent No. 6,424,461 is cited as of specific interest in that it discloses the system claimed in pending claims 11 and 15; however, the Patent has a filing date of 8/15/2000 which is later than the filing date, 6/22/2000, of the present application.

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

January 21, 2003